

### REMARKS

The objection of claim 20 and the rejection of claims under 35 USC 112, second paragraph, should be withdrawn in light of this Amendment.

Claims 1, 5, 7, 14, 17, 21 and 25 were rejected as being anticipated by Nolan. Claims 2-4, 15 and 22 were rejected as being obvious over Nolan. These rejections are respectfully traversed.

The Examiner has acknowledged that Nolan discloses that “[e]ach of the crystalline layers is *nonmagnetic*.” [Emphasis added.] Then the Examiner states that “[t]he examiner takes the position that the Ru layer taught by Nolan *would be capable* of providing RKKY coupling between the first and third intermediary layer *if* they were both magnetic by virtue of the fact that is formed of the same material s disclosed by Applicants.” [Emphasis added.]

Applicants respectfully submit that Nolan fails to disclose, either explicitly or inherently, “a property of providing RKKY coupling between the first intermediary layer and the third intermediary layer when the first intermediary layer and the third intermediary layer are magnetic layers” as each of the three crystalline layers of Nolan is *non-magnetic*. Three *non-magnetic* crystalline layers of Nolan *cannot* provide RKKY coupling between the first and third intermediary layers. The Examiner is simply applying hindsight in making the statement that “[t]he examiner takes the position that the Ru layer taught by Nolan *would be capable* of providing RKKY coupling between the first and third intermediary layer *if* they were both magnetic by virtue of the fact that is formed of the same material s disclosed by Applicants.” [Emphasis added.]

Applicants respectfully submit that the prior art “would be capable” under some hypothetical arrangement based on hindsight gained from Applicants invention is clearly not a legal basis to establish a *prima facie* case of anticipation or obviousness. Instead, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of [anticipation or] obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of [lack of anticipation or] nonobviousness.” [MPEP 2142, emphasis

added.] Furthermore, hindsight is not a proper basis for a *prima facie* case of anticipation or obviousness.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing Docket No. 146712004800.

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Respectfully submitted,

By 

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